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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,804	05/11/2001	Takao Kasai	0445-0299P	5485

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/852,804

Applicant(s)

KASAI ET AL.

Examiner

Jacqueline F Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 7/2/03 have been fully considered but they are not persuasive. Applicant argues the Declaration filed 6/2/03 is now applicable to the amended claims. Applicant explains the Declaration is now relevant because the amended claims limit the agent to "not causing a substantial reduction in water absorbing performance of the superabsorbent polymer", and purportedly, this language is similar to the examiner's statement that "the water absorbing component is hindered in its capability to absorb water". However, the examiner's above statement in the Advisory Action mailed 6/16/03 was referring to the teaching in the Declaration that the *concentration* of zinc sulfate used with a super absorbent polymer has an inverse relationship to the water absorption capacity. Additionally, the examiner indicated that it stands to reason that the greater the amount of a non-water absorbing agent added to a product, the less water absorbent capacity the product will have. The examiner further indicated that, Paul teaches an absorbent article comprising an agent having a skin-care effect and the absorbent article has a superabsorbent polymer with a water absorption capacity within the claimed range of the water absorption capacity of dependent claim 4. Therefore, it is reasonable to assume the skin care agent does not affect the water absorption capacity of the superabsorbent polymer, and furthermore, since the invention of Paul has the claimed water absorption capacity, it is understood the concentration of the agent used is appropriate for the intended use of the article.

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Therefore, applicant's present arguments and the declaration filed 6/2/03 has been fully considered but is not persuasive.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-7, 9, 12, and 13, as best understood by the examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Paul et al. (USPN 6217890 B1).

Regarding claims 1, 4, 12, and 13, Paul discloses an absorbent article comprising a liquid-permeable top layer 22, a liquid-impermeable leak-proof layer 20, and an absorbent layer containing a superabsorbent polymer (Abstract and col. 24, lines 17-32) between the top layer and the leak proof layer (col. 10, lines 29-49). Paul discloses an agent having a skin care effect that is activated on contact with moisture (col. 23, lines 66 through col. 24, lines 16). Paul further discloses the superabsorbent polymer has a water absorption within the claimed range (col. 24, lines 57-62).

Therefore, it is reasonable to assume the skin care agent does not cause a substantial reduction in water absorbing performance of the superabsorbent polymer. Paul discloses the agent contains a water-soluble viscosity enhancer (thickener) (col. 13, lines 55-64 and col. 15, lines 7-21).

Regarding claim 2, Paul discloses the agent is fixed on a skin-contacting surface of the article (col. 17, lines 41-45).

Regarding claim 3, Paul discloses the agent comprises a water-soluble or water-dispersible plant extract (col. 20, lines 51-65).

Regarding claims 5-7, Paul discloses the absorbent article comprises a liquid-retentive absorbent layer, a liquid-impermeable leak-proof layer, and an agent having an effect on the skin of a wearer on the skin-contacting surface of the article (Abstract, col 17, lines 41-45). Paul further discloses the superabsorbent polymer has a water absorption within the claimed range (col. 24, lines 57-62). Therefore, it is reasonable to assume the skin care agent does not cause a substantial reduction in water absorbing performance of the superabsorbent polymer. Paul discloses the agent contains a water-soluble viscosity enhancer (thickener) (col. 13, lines 55-64 and col. 15, lines 7-21). Claim 7, is a product-by-process claim, which is limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re

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Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

MPEP 2113.

Regarding claim 9, Paul discloses the agent has a dissolving temperature of 30-100°C, which includes the claimed range of 40-100°C (col. 16, lines 53-61).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul in view of Yanaki et al. (USPN 5538728). Paul discloses the present invention substantially as claimed. However, Paul fails to disclose the water-soluble thickener

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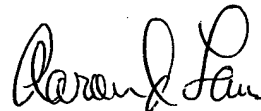
comprises the claimed material. Yanaki discloses polysaccharide used as a thickener in a skin care composition (col. 3, lines 19-25 and col. 4, lines 11-14, and col. 8, lines 15-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate polysaccharide in the agent of Paul. Doing so would provide a water-soluble thickener that gives enhanced viscosity without providing a sticky feeling as taught by Yanaki.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens  
Examiner  
Art Unit 3761



Aaron J. Lewis  
Primary Examiner

July 11, 2003